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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,655	03/16/2001	Areal Guerra Rogelio	G80-019 US	2667

7590

09/26/2002

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New York, NY 10118-0110

EXAMINER

ALVO, MARC S

ART UNIT	PAPER NUMBER
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1731

15

DATE MAILED: 09/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-15

Office Action Summary	Application No.	Applicant(s)	
	09/744,655	ROGELIO, AREAL GUERRA	
	Examiner	Art Unit	
	Steve Alvo	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1. Newly submitted claims directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The original claims where all depended on product claim 1 and probative weight was only given to the product. The instant claims belong to the following Groups:

Group I, claim(s) 1-14, drawn to a product for deacidifying porous material.

Group II, claim(s) 15-19, drawn to a method of making a product.

Group III, claim(s) 20, drawn to a process of deacidifying paper.

Restriction to one of the following inventions is required under 35 U.S.C. § 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-14, drawn to a product for deacidifying porous material.

Group II, claim(s) 15-19, drawn to a method of making a product.

Group III, claim(s) 20, drawn to a process of deacidifying paper.

The inventions listed as Groups I and II do not relate to a single general concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Claim 1 is either obvious over or anticipated by CANADIAN PATENT 2,142,195.

Accordingly, the special feature linking the providing a composition of carbonated magnesium

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di-n-propylate in n-propanol, does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore, restriction is appropriate.

Since applicant has received an action on the merits for the originally presented invention, a product for the delignification of a porous material, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

See **MPEP 818.02(a): “By Originally Presented Claims”**

Where claims to another invention are properly added and entered in the application before an action is given, they are treated as original claims for purposes of restriction only.

The claims originally presented and acted upon by the Office on their merits determine the invention elected by an applicant in the application, and in any request for continued examination (RCE) which has been filed for the application. Subsequently presented claims to an invention other than that acted upon should be treated as provided in MPEP § 821.03 below:

MPEP 821.03 “Claims for Different Invention Added After an Office Action”

Claims added by amendment following action by the examiner, MPEP § 818.01, § 818.02(a), to an invention other than previously claimed, should be treated as indicated by 37 CFR 1.145.

37 CFR 1.145. Subsequent presentation of claims for different invention.

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If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

It is noted that the "clean copy" of claim 5, was corrected and thus is not a clean copy. A new "clean copy" of claim 5 should be submitted.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as obvious over CANADIAN PATENT 2,142,195.

CANADIAN PATENT 2,142,195 teaches deacidifying paper (cellulose-type material) by preparing a solution of carbonated alkoxymagnesium compounds (page 6, lines 1-8) and diluted with a hydro fluorocarbon. CANADIAN PATENT 2,142,195 teaches using several different homologs of alkoxymagnesium compounds, e.g. methoxymagnesium methyl carbonate and ethoxymagnesium methyl carbonate and teaches that "other suitable carbonated magnesium alkoxides can be prepared by either of the above methods using other solvents to produce the corresponding homologs of methoxymagnesium methyl carbonate", see page 13-16.

CANADIAN PATENT 2,142,195 teaches using methanol to produce methoxymagnesium methyl carbonate and ethanol to produce ethoxymagnesium methyl carbonate. Thus it would have been obvious to use the homolog propanol to produce the homolog carbonated magnesium

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propoxide, e.g. carbonated magnesium di-n-propylate. See page 6, lines 26-27 for carbonated magnesium alkoxide in diluent of 0.1 to 2 %. The exact amounts of components would have been obvious to the routineer. Page 7, lines 29-33 teaches reducing the water content when using the composition. It would have been obvious to the artisan to use as high a concentration of active ingredients as possible. Claims 7 and 8, see CANADIAN PATENT 2,142,195, page 5, line 27-page 6, line 8.

The argument that the instant solvents can be used in higher concentrations than the CANADIAN PATENT is not convincing as claims 2 and 12 call for a concentration of 1-10 %. This does not differ from the 2.0, e.g. the 0.1 to 2% disclosed by the CANADIAN PATENT (page 6, lines 20-21). The adjusting of the concentrations of components would have been obvious to the routineer. A comparison should be made to the claimed 30% carbonated magnesium di-n-propylate to the amounts of alkoxymagnesium compounds used by the CANADIAN PATENT.

When filing an “Official” FAX in Group 1730, please indicate in the Header (upper right) “Official” for papers that are to be entered into the file. The “Official” FAX phone numbers for this TC 1700 are:

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Any inquiry concerning this communication or earlier communications from the **primary examiner** should be directed to **Steve Alvo** whose telephone number is **(703) 308-2048**. The Examiner can normally be reached on Monday - Friday from **6:00 AM - 2:30 PM (EST)**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on 703-308-3837.

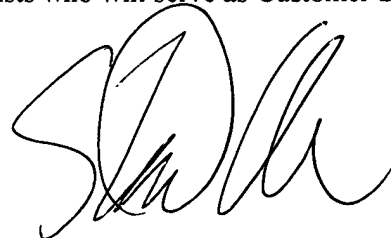
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is **(703) 308-0661**.

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STEVE ALVO
PRIMARY EXAMINER
ART UNIT 1731

MSA
9/25/02